

REMARKS

Claims 1-13 are currently pending in the present application. Applicant has amended claims 1, 4, 9, and 10 to further particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The amendments to the claims presented herein do not introduce new matter within the meaning of 35 U.S.C. §132. Accordingly, the Examiner is respectfully requested to enter these amendments.

1. Rejection of Claims 1, 4, 9, and 10 Under 35 U.S.C. § 112, 2nd

Paragraph

The Office Action states that claims 1, 4, 9, and 10 are rejected under 35 U.S.C. §112, 2nd Paragraph, as being indefinite. In particular, the Office Action states,

Claims 1, 4 and 9-10 recite the limitation "said C₄ - C₁₀ alpha-olefins." There is insufficient antecedent basis for this limitation in the claim.

RESPONSE

Applicant has amended claims 1, 4, 9, and 10 to further particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection to pending claims 1, 4, 9, and 10.

2. Foreign Priority Claim

The Office Action states,

This application is a case filed under 35 USC 371 claiming priority to PCT/EP03/02518 filed on 03/06/2003. The Applicants have not submitted the foreign priority document(s) as noted on the Request. Do Applicants intend to claim foreign priority.

RESPONSE

Applicant thanks the Examiner for bringing this to Applicant's attention. As the Examiner correctly notes, Applicant filed the current application under 35 U.S.C. 371 claiming priority to EP 02075992.4 filed on March 12, 2002. Additionally, upon entering the U.S. as a national phase filing, Applicant requested the receiving Office to prepare and transmit a certified copy of the above cited European application to the International Bureau. (See sheet no. 6, Box No. VI on form PCT/RO/101) Accordingly, Applicant kindly requests the Examiner and U.S. Patent and Trademark Office to formally acknowledge Applicant's claim to foreign priority.

3. Rejection of Claims 1-13 Under 35 U.S.C. §102(b)

The Office Action states,

Claims 1-13 are rejected under 35 U.S.C.102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pellegatti et al., EP 0 640 649 B1 (hereinafter "Pellegatti"). Pellegatti discloses a polyolefin composition comprising (a) 30-60% propylene homopolymer, (b) 14-30% copolymers of propylene with ethylene, (c) 10-25% copolymer of ethylene/C₄-C₁₀ olefins and (d) 5-45% filler. See Pellegatti, page 2, lines 33-45. Although Pellegatti does not disclose all the characteristics and properties of the polymer components

disclosed in the present claims, based on the overall monomer composition and the amount of each respective polyolefin component, the Examiner has a reasonable basis to believe that the properties claimed in the present invention is inherent in the compositions disclosed by Pellegatti. Because the PTO has no means to conduct analytical experiments, the burden of proof is shifted to the Applicants to prove that the properties are not inherent. See In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Best, 195 USPQ 430 (CCPA 1977); In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995).

The claiming of a new use, new function or unknown property, which is inherently present in the prior art does not necessary make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). However, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See In re Rijckaert, 9 F.3d. 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessary due to optimization of conditions, not what was necessarily present in the prior art). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing describe in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" See In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

RESPONSE

Applicant traverses the rejection of claims 1-13.

For a reference to anticipate an invention, all of the elements

of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claims is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (Emphasis added) The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (Emphasis added) The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applicant respectfully submits that Pellegatti, et al. fails to teach, suggest, or disclose "A masterbatch composition comprising (percentage by weight):

- 1) 10-45% of a crystalline propylene homopolymer;
- 2) 55-90% of a blend consisting of:
 - a) a copolymer (a) of ethylene and at least one C₄-C₁₀ α-olefin of formula H₂C=CHR, where R is a C₂-C₈ linear or branched alkyl radical, and containing 10-40% of said C₄-C₁₀ α-olefin(s); and
 - b) an amorphous copolymer (b) of propylene and ethylene, wherein an ethylene content is from 20-70%, and having an intrinsic viscosity value of a xylene-soluble moiety of from 2.2 to 3.5 dL/g, this value being equal to 0.8 to 1.2 times the intrinsic viscosity value of a xylene-soluble moiety of copolymer (a); wherein a weight ratio between copolymer (a) and copolymer (b) is from 3/1 to 1/3," as currently recited by claim 1.

Additionally, Pellegatti, et al. fails to teach, suggest, or disclose "A thermoplastic polyolefin composition containing a masterbatch composition comprising (percentage by weight):

- 1) 10-45% of a crystalline propylene homopolymer;
- 2) 55-90% of a blend consisting of:
 - a) a copolymer (a) of ethylene and at least one C_4-C_{10} α -olefin of formula $H_2C=CHR$, where R is a C_2-C_8 linear or branched alkyl radical, and containing 10-40% of said C_4-C_{10} α -olefin(s); and
 - b) an amorphous copolymer (b) of propylene and ethylene, wherein an ethylene content is from 20-70%, and having an intrinsic viscosity value of a xylene-soluble moiety of from 2.2 to 3.5 dL/g, this value being equal to 0.8 to 1.2 times the intrinsic viscosity value of a xylene-soluble moiety of copolymer (a); wherein a weight ratio between copolymer (a) and copolymer (b) is from 3/1 to 1/3," as currently recited by claim 4.

Moreover, Pellegatti, et al. fails to teach, suggest, or disclose "An automotive part comprising a masterbatch composition comprising (percentage by weight):

- 1) 10-45% of a crystalline propylene homopolymer;
- 2) 55-90% of a blend consisting of:
 - a) a copolymer (a) of ethylene and at least one C_4-C_{10} α -olefin of formula $H_2C=CHR$, where R is a C_2-C_8 linear or branched alkyl radical, and containing 10-40% of said C_4-C_{10} α -olefin(s); and
 - b) an amorphous copolymer (b) of propylene and ethylene, wherein an ethylene content is from 20-70%, and having an intrinsic

viscosity value of a xylene-soluble moiety of from 2.2 to 3.5 dL/g, this value being equal to 0.8 to 1.2 times the intrinsic viscosity value of a xylene-soluble moiety of copolymer (a); wherein a weight ratio between copolymer (a) and copolymer (b) is from 3/1 to 1/3," as currently recited by claim 9.

Even more so, Pellegatti, et al. fails to teach, suggest, or disclose "A process for preparing a masterbatch composition comprising (percentage by weight):

- 1) 10-45% of a crystalline propylene homopolymer;
- 2) 55-90% of a blend consisting of:

- a) a copolymer (a) of ethylene and at least one C₄-C₁₀ α -olefin of formula H₂C=CHR, where R is a C₂-C₈ linear or branched alkyl radical, and containing 10-40% of said C₄-C₁₀ α -olefin(s); and

- b) an amorphous copolymer (b) of propylene and ethylene, wherein an ethylene content is from 20-70%, and having an intrinsic viscosity value of a xylene-soluble moiety of from 2.2 to 3.5 dL/g, this value being equal to 0.8 to 1.2 times the intrinsic viscosity value of a xylene-soluble moiety of copolymer (a); wherein a weight ratio between copolymer (a) and copolymer (b) is from 3/1 to 1/3 by a sequential polymerization, comprising at least three sequential steps, wherein components 1) and 2) are prepared in separate subsequent steps, operating in each step, except the first step, in the presence of the polymer formed and the catalyst used in the preceding step" as currently recited by claim 10.

In particular, Pellegatti, et al. fails to teach, suggest, or

disclose the currently claimed ranges as recited by independent claims 1, 4, 9, and 10. Additionally, Pellegatti, et al. fails to teach, suggest, or disclose, "an amorphous copolymer (b) of propylene and ethylene, wherein an ethylene content is from 20-70%, and having an intrinsic viscosity value of a xylene-soluble moiety of from 2.2 to 3.5 dL/g, this value being equal to 0.8 to 1.2 times the intrinsic viscosity value of a xylene-soluble moiety of copolymer (a); wherein a weight ratio between copolymer (a) and copolymer (b) is from 3/1 to 1/3" as recited by independent claims 1, 4, 9, and 10.

Accordingly, Pellegatti, et al. does not anticipate the currently pending claims.

Moreover, the Office Action states, "Although Pellegatti does not disclose all the characteristics and properties of the polymer components disclosed in the present claims, based on the overall monomer composition and the amount of each respective polyolefin component, the Examiner has a reasonable basis to believe that the properties claimed in the present invention is inherent in the compositions disclosed by Pellegatti."

Applicant respectfully traverses the Examiner's assertion that Pellegatti, et al. inherently contains all of the non-disclosed currently pending claim limitations. As outlined above, Pellegatti, et al. does not teach, suggest, or disclose the currently claimed range of components 1) and 2) as recited by independent claims 1, 4, 9, and 10. Accordingly, since the ranges as disclosed by

Pellegatti, et al. are different than those currently claimed, Applicant submits the Examiner has not provided a sufficient basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of Pellegatti, et al. as required by *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Additionally, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). (Emphasis added)

Claims 2 and 3 depend directly or indirectly from claim 1, while claims 5-8 depend directly or indirectly from claim 4, and claims 11-13 depend directly or indirectly from claim 1, with dependent claims 2, 3, 5-8, and 11-13 necessarily including all of the limitations of any claim from which they depend.

In light of the above, claims 1-13 are therefore deemed not to

be anticipated by the Pellegatti, et al. patent. Accordingly, reconsideration and withdrawal of the rejection is requested.

4. Rejection of Claims 1-13 Under 35 U.S.C. 103(a)

The Office Action states,

Even if the disclosure of Pellegatti does not satisfy the requirements of 35 USC 102(b), it still would have been obvious to one of ordinary skill in the art to arrive at the claimed compositions, because it appears that the claimed compositions are within the generic disclosure of Pellegatti and a person of ordinary skill in the art would have expected all embodiment of Pellegatti to have similar properties. Particularly, the use of an additional polyolefin component (instant claim 6) in the blend and 60-80% component (2) (instant claim 12) is obvious to one of ordinary skill in the art.

Pellegatti teaches the use of an assortment of polyolefins as a part of the overall composition. For instance, Pellegatti teaches propylene homopolymer or copolymer may be used as component (a). To one of ordinary skill the use of both is also a possibility considering that ethylene/propylene copolymers can be used as components (b) or (c). Also 55% of component (2) as taught by Pellegatti is sufficiently close to 60% as described in the claimed invention.

Applicant has not demonstrated that the differences, if any, between the claimed composition and the compositions disclosed by Pellegatti give rise to unexpected results. The evidence presented to rebut the prima facie case of obviousness must be commensurate in scope with the claims to which it pertains. See *In re Dill and Scales*, 202 USPQ805 (CCPA 1979).

RESPONSE

Applicant traverses the rejection of claim 1-13.

The U.S. Supreme Court in *Graham v. John Deere Co.*, 148 U.S.P.Q. 459 (1966) held that non-obviousness was determined under §

103 by (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the art; and, (4) inquiring as to any objective evidence of non-obviousness.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all the claim limitations. Amgen, Inc. v. Chugai Pharm. Co., 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Wilson, 165 USPQ 494, 496 (C.C.P.A. 1970).

Arguments from section 3 are incorporated herein.

Applicant respectfully submits that Pellegatti, et al. fails to teach or suggest all of the claim limitations as recited by independent claims 1, 4, 9, and 10. In particular, Pellegatti, et al. fails to teach, suggest, or disclose the currently claimed ranges as recited by independent claims 1, 4, 9, and 10.

Additionally, Pellegatti, et al. fails to teach, suggest, or disclose, "an amorphous copolymer (b) of propylene and ethylene, wherein an ethylene content is from 20-70%, and having an intrinsic viscosity value of a xylene-soluble moiety of from 2.2 to 3.5 dL/g, this value being equal to 0.8 to 1.2 times the intrinsic viscosity value of a xylene-soluble moiety of copolymer (a); wherein a weight ratio between copolymer (a) and copolymer (b) is from 3/1 to 1/3" as recited by independent claims 1, 4, 9, and 10.

As outlined above, Pellegatti, et al. does not disclose all of the currently pending claim limitations, nor does Pellegatti, et al. teach or suggest all of the currently pending claim limitations as required by Amgen, Inc. v. Chugai Pharm. Co., 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); In re Wilson, 165 USPQ 494, 496 (C.C.P.A. 1970). Additionally, there is no suggestion or motivation to modify Pellegatti, et al. to arrive at the currently pending claims, nor has the Examiner provided any evidence that there would have been a reasonable expectation of success.

Accordingly, Applicant respectfully asserts the Examiner has not established a *prima facie* case of obviousness.

Claims 2 and 3 depend directly or indirectly from claim 1, while claims 5-8 depend directly or indirectly from claim 4, and claims 11-13 depend directly or indirectly from claim 1, with dependent claims 2, 3, 5-8, and 11-13 necessarily including all of the limitations of any claim from which they depend.

In light of the above, claims 1-13 are therefore deemed not to be obvious in view of the Pellegatti, et al. patent. Accordingly, reconsideration and withdrawal of the rejection is requested.

CONCLUSION

Based upon the above remarks, the presently claimed subject matter is believed to be novel and patentably distinguishable over the prior art of record. The Examiner is therefore respectfully

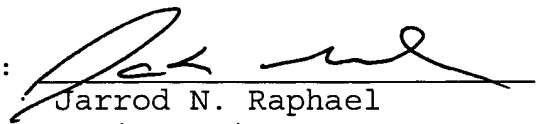
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requested to reconsider and withdraw all rejections and allow all pending claims 1-13. Favorable action with an early allowance of the claims pending in this application is earnestly solicited.

The Examiner is welcomed to telephone the undersigned practitioner if he has any questions or comments.

Respectfully submitted,

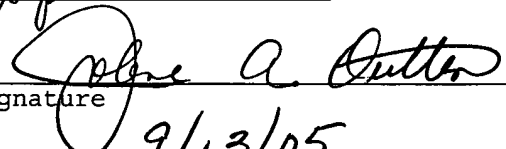
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on September 13, 2005.



Signature

Date

9/13/05